

REMARKS

In accordance with the foregoing, claims 1-10 and 20-27 are pending and under consideration. No new matter is presented in this Amendment.

INTERVIEW SUMMARY:

The Final Rejection mailed on October 26, 2007, appeared to be identical to the Non-Final Rejection mailed November 14, 2006, with the exception of a "Response to Arguments" section. As the rejections in the November 2006 Office Action were substantially different from the rejections in the second Non-Final Rejection mailed on May 17, 2007, the applicants contacted the Examiner regarding this discrepancy. Upon reviewing the case, the Examiner agreed that the October 26, 2007 Final Rejection was in error, and the Examiner agreed to send out a second, corrected Office Action.

RESPONSE TO EXAMINER'S ARGUMENTS:

The Examiner indicated that the amendments to the claims filed on August 16, 2007, would not be given patentable weight. The applicants respectfully disagree. Prosecution of this case should be reopened so that the Examiner can fully consider, and give patentable weight to, the amendments filed on August 16, 2007.

The Examiner failed to give patentable weight to the amendments because the amendments affected only the preamble of the claims, and the preamble is not given patentable weight. As a general rule, the Examiner is correct in that limitations found only in the preamble are not usually given patentable weight. However, this rule is subject to an exception where the limitations breathe life and meaning into the claims. In *Catalina Marketing Int'l v. Coolsavings.com Inc.*, the Federal Circuit set out several situations where a limitation in the preamble may be considered a limitation of the claim. The preamble of a Jepson claim limits the scope of the claim. If a limitation in the body of the claim relies on the preamble for antecedent support, the preamble will limit the scope of the claim. The preamble may also act as a claim limitation if the preamble contains structures or steps underscored by the specification as important to the invention. Finally, reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation. See *Catalina Marketing Int'l v. Coolsavings.com Inc.*, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002).

At least two of these exceptions apply in this case. For example, the preamble of the claims includes limitations relied upon in the body for antecedent support. Claim 1 defines an apparatus to record and/or reproduce data from an "optical information storage medium" and "reproduction-related user data" are first recited in the preamble, not the body. Claim 20 includes similar recitations. Further, the applicants have relied upon the preamble to distinguish the apparatus and method as recited in the claims from the apparatuses and methods disclosed in the prior art, as outlined in the remarks filed with the amendment of August 16, 2007 and reproduced below. Thus, at least two of the exceptions to the general rule apply in this case. Accordingly, the amendments to the preamble should be given patentable weight, and the Examiner should reopen prosecution of this case so as to consider the amendments filed on August 16, 2007, which the Examiner has not yet fully considered.

REJECTIONS UNDER 35 U.S.C. §102:

Claims 1-3, 10, 20-22 and 27 are rejected under 35 U.S.C. §102(b) as being anticipated by Kobayashi (U.S. Patent 6,097,695). The applicant respectfully traverses the rejection.

Kobayashi discloses a method and apparatus for manufacturing optical disks (Kobayashi, col. 1, lines 8-10.) An optical head uses a laser beam to create a groove running from an internal circumference of an optical disk to an external circumference of the optical disk (col. 3, lines 53-55). The optical head is driven based on a wobble signal (col. 4, lines 20-23.) This wobble signal is created, in part, by performing biphasic modulation on wobble data (col. 5, lines 20-21). The bi-phase-modulated wobble data is subsequently phase-modulated to generate the wobble signal (col. 5, lines 55-60.) Since the entire groove is formed based on the wobble signal, the wobble data is recorded throughout the disk.

Kobayashi further discloses a way to access the optical disk and retrieve the wobble data and user data recorded on the disk (Figures 6 and 7). A laser is aimed at the disk and the reflected light is split into two beams by a beam splitter (col. 7, lines 42-43). One of the beams is received by a photodetector 23, which detects a push-pull signal PP (col. 7, lines 56-57.) Another beam is received by two photodetectors 28 and 29, which outputs a reproduced signal MO (col. 8, lines 8-19.) The push-pull signal PP is used to extract the wobble data (col. 10, lines 7-9.)

In contrast, claim 1 recites, *inter alia*, an optical information storage medium whereon optical information storage medium-related information is recorded in at least a portion of the

lead-in area but not in the user data area by a first modulation method and reproduction-related user data are recorded in a portion of a remaining area of the optical information storage medium by a second modulation method which is different from the first modulation method, a reproduction-related user (RRU) data demodulator which demodulates the reproduction-related user data from a sum signal of the first and second electrical signals, and a read only memory-permanent information control (ROM-PIC) data demodulator which demodulates the optical information storage medium-related information from the sum signal.

Kobayashi does not disclose all the limitations of claim 1 as amended. For example, Kobayashi fails to disclose the ROM-PIC data demodulator recited by claim 1. The wobble data of Kobayashi is related to address data including the frame number (Sync no.) and track number (Track no.). Kobayashi, col. 4, lines 19-41. Furthermore, a frame number is allocated in each frame and a track number is allocated in each track, therefore the address data should be recorded in the at least user data area. The ROM-PIC data demodulator, as recited in claim 1, demodulates the optical information storage medium-related information from the sum signal. However, the optical information storage medium-related information from which the ROM-PIC demodulator reproduces the data is recorded in "at least a portion of the lead-in area but not in the user data area". The optical information storage medium-related information cannot be related to the address data disclosed by Kobayashi, since the address data disclosed by Kobayashi is recorded in the user data area. Thus, because the optical information storage medium-related information recited by claim 1 is different from the wobble data disclosed in Kobayashi, and because the ROM-PIC data demodulator recited by claim 1 demodulates the optical information storage medium-related information from the sum signal, it is respectfully submitted that Kobayashi does not disclose a ROM-PIC data demodulator that reads optical information storage medium related-information recorded in at least a portion of the lead-in area but not in the user data area. Accordingly, since Kobayashi does not disclose all the limitations of claim 1, the rejection of claim 1 should be withdrawn.

As to claims 2, 3, and 10, claims 2, 3, and 10 depend from claim 1 and are patentable for at least the reasons given above with respect to claim 1.

As to claim 20, claim 20 contains language similar to claim 1 and is deemed patentable for at least the reasons given above with respect to claim 1. Claims 22 and 27 depend from claim 1, and the rejection of claims 22 and 27 should be withdrawn for the reasons given above with respect to claim 1.

REJECTIONS UNDER 35 U.S.C. §103:

Claims 4-9 and 23-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kobayashi (U.S. Patent 6,097,695). The applicant respectfully traverses the rejection.

Claims 4-9 depend from claim 1 and claims 23-26 depend from claim 20. As discussed above, Kobayashi fails to disclose all the limitations of claims 1 and 20. Thus, it is respectfully submitted that claims 4-9 and 23-26 are patentable for at least the same reasons that claims 1 and 20 are patentable, respectively.

Based on the foregoing, this rejection is respectfully requested to be withdrawn.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

This response is filed pursuant to 37 C.F.R. § 1.116 and should be considered because no new search would be required and because the remarks, if considered by the Examiner, would place the application in better condition for appeal. No new search would be required because the claims have not been further amended, and the Examiner thus should have already conducted a full search on the claims as currently presented. Further, consideration of the above remarks would avoid presenting the Board with claims containing limitations not previously given patentable weight by the Examiner.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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